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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,800	09/19/2003	Gregory Scott Clark	215.1014.02	3481
22883	7590	07/26/2006	EXAMINER	
SWERNOFSKY LAW GROUP PC P.O. BOX 390013 MOUNTAIN VIEW, CA 94039-0013			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			2168	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,800	Applicant(s) CLARK, GREGORY SCOTT	
	Examiner Cheyne D. Ly	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☒ Claim(s) 7 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group II, claims 7-16 in the reply filed on June 30, 2006 is acknowledged. Applicant argues that "the claims in Groups I and II to least some degree cover at least similar subject matter...examination of claims 1-6 along with claims 7 to 16 would not be unduly burdensome." Applicant's argument is not persuasive because Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II requires the steps of determining the availability of a part associated with said universal part number, generating a document summarizing a transaction, and storing a record of said transaction. The subcombination has separate utility such as a function in an ordering system.
2. Further, Group I requires a dedicated server and a database coupled to a dedicated server, while Group II is directed to client workstations. The distinct critical features of each Group support the undue search burden if they were examined together.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes as indicated is proper.
4. The withdrawal of claims 1-6 has been acknowledged.
5. The IDS, filed October 31, 2003, has been considered.

6. Claims 7-16 are examined on the merits.

OBJECTIONS

7. Applicant has cited Application Serial No. 09/823,888 as a related application (page 6, line 10). Applicant is required to update the status of said application because said application has been issued as Patent No. 6,823,340.
8. Applicant has cited "patent application no. 08/823,888" (page 9, line 18) which has been interpreted as a typographical error. Further, Applicant is required to update the status of said application because Application Serial No. 09/823,888 has been issued as Patent No. 6,823,340.
9. Claims 7 and 12, line 3, are objected to because said line recites the phrase "a client workstations", which is grammatically incorrect. Applicant is advised to amend the claim to recite "workstation".
10. Claims 7 and 12 are objected to because line 4 recites the term "engaged", which has been interpreted as a typographical error. Applicant is advised to amend the claim to recite "engage."

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

12. Claims 7-10 and 12-15 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Chow et al. (US 20030101168A1) (Chow hereafter).

CLAIMS INTERPRETATIONS

13. It is noted that Application does not specifically define the limitation of “proprietary part numbers.” Therefore, the disclosure of “internal part numbers” by Chow has been interpreted as a type of “proprietary part number.”

BASIS FOR PRIOR ART

14. In regard to claim 7, Chow discloses a method for translating (page 1, [0007]) a first set of proprietary part numbers (page 5, column 2, lines 1-3) over a network (Figure 3), including steps of

Receiving a first set of proprietary part numbers from a client workstations (page 5, column 2, lines 1-3), wherein a user of said client workstation wishes to engaged in supply chain management, design collaboration, or the purchase or sale of services or fungible goods (Figure 3);

Checking a database for said first set of proprietary part numbers (page 5, lines 4-9);

Translating said first set of proprietary part numbers into a universal part number (page 1, [0007], page 5, [0036] to [0039], and claim 3);

Determining the availability of a part associated with said universal part number (page 2, [0018]);

Generating a document summarizing a transaction involving one or more parts associated with said universal part number (claims 3, 6, and 7);

Translating said document from said universal numbers into a proprietary part number included in said set of proprietary part numbers (claim 15); and

Storing a record of said transaction in a database (page 2, [0018] to [0022]).

15. In regard to claim 8, Chow discloses each said universal part number is associated with other part numbers such as may be associated with different suppliers or manufacturers (page 1, [0007], and page 5, [0036] to [0039]).
16. In regard to claim 9, Chow discloses the database (page 2, [0018] to [0021]) includes a translation module for translating one or more proprietary part numbers associated with an order into different part numbers (page 1, [0003]) that the recipient of a document readily understands (page 1, [0007], and page 5, [0036] to [0039]).
17. In regard to claim 10, Chow discloses the translation module is used to prepare commercial documents (page 1, [0002], and page 2, [0018] to [0022]).
18. In regard to claims 12-15, Chow discloses a memory (page 2, [0019] to [0020]) including instructions for implemented the method cited above.

CLAIM REJECTIONS - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow et al. (US 20030101168A1) (Chow hereafter) as applied to claims 7-10 and 12-15 above, and further in view of Peterson et al. (US006324522B2) (Peterson hereafter).
21. Chow describes a universal part number scheme that allows a user to more effectively utilize internal part numbers, to formulate more accurate item prices using leveraged volume aggregation techniques, and to reduce the complexity and cost for a user to manage and maintain a database of part numbers (page 1, [0007]). While, Peterson describes distribution networks for distributing parts from a manufacturer, through vendors to end-users. Therefore, one of ordinary skill in the art would have been motivated by the improvement described by Chow to improve the distribution networks of Peterson.
22. In regard to claims 11 and 16, Chow describes an approval process for mapping part numbers based on certain business rules (page 3, [0026]). However, Chow does not describe a management module that identifies what parties may create associations between part numbers or enter new part numbers. Peterson describes Inventory Networks allow selected users (what parties) to share inventory information wherein vendors electronically send their inventory data files comprising part numbers or universal product code (page 13, line 40, to page 15, line 36).
23. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the method and memory described by Chow with the management module that identifies what parties may create associations between part

numbers or enter new part numbers as described by Peterson, to more effectively utilize internal part numbers etc.

CONCLUSION

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 20030115115A1
- US 20030036968A1
- US 20030172051A1
- US 20020188528A1

25. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance.

Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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26. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-

9199. The USPTO's official fax number is 571-272-8300.

27. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly
Patent Examiner

7/23/06

